

Atty. Dkt. No. (Old) 22754X
Atty. Dkt. No. 054707-0661
Appln. No. 09/835,523

REMARKS

I. Introduction

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 41-47 are requested to be cancelled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicant(s) reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

Claims 1, 3-4, 7, and 10 are currently amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 1-4, 7-10 and 48 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

II. Response to Issues Raised by Examiner in Outstanding Office Action

a. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1 and 7 are rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite. The Office believes the use of “-CR₃” creates an incomplete valence for the claimed compound. Applicants have amended the claims to provide for “-C(R₃)₃” and believe the claim would be clear to one of skill in the art. Applicants note paragraph [0099] explaining the use of substituents throughout the specification. As the specification notes, “It is intended that all “R_n” are selected independently of all other “R_n” whether or not the term

Atty. Dkt. No. (Old) 22754X
Atty. Dkt. No. 054707-0661
Appln. No. 09/835,523

‘independently selected’ is used or is inadvertently omitted.” Applicants respectfully request reconsideration and withdrawal of the rejection.

b. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 7 and 10 are rejected under 35 U.S.C. § 112, first paragraph for lack of enablement. The Examiner asserts that the claims are enabled for peripheral neuropathy, but do not reasonably provide enablement for the treatment of Alzheimer’s disease, Parkinson’s disease, Huntington’s disease, or ALS. Office Action, pp. 2-3.

Applicants disagree with the Examiner, but in order to further prosecution of this case, Applicants have amended claims 7 and 10 to remove Alzheimer’s disease, Huntington’s disease, and ALS.

As to Parkinson’s disease, Applicants have presented extensive data regarding the effectiveness of 15 compounds in the treatment of Parkinson’s disease in Example 13. These data provide extensive evidence for the ability to treat Parkinson’s disease in a system used to model Parkinson’s treatment. As noted in MPEP 2164.02, “An *in vitro* or *in vivo* animal model example in the specification, in effect, constitutes a “working example” if that example “correlates” with a disclosed or claimed method invention.” The data provide a correlation between Parkinson’s disease and the biological activity of the compounds. See Office Action, p. 3, paragraph 2. Example 13 specifically recognizes the relationship between dopamine and Parkinson’s and provides the percentage recovery of TH-stained dopaminergic neurons. As indicated in Table V, the compounds cause a significant affect in the treatment of Parkinson’s. Based on the data provided in the application, Applicants believe a person of skill in the art would appreciate the beneficial effect of the claimed compounds in the treatment of Parkinson’s disease and could make and use the compounds to treat the disease. Applicants respectfully request reconsideration and withdrawal of the rejection.

c. Claim Rejections - 35 U.S.C. § 103

Claims 1, 2, 4, and 48 are rejected under 35 U.S.C. § 103 as being obvious over Casini et al. (EP 572,365). Applicants respectfully request reconsideration and withdrawal of the rejection.

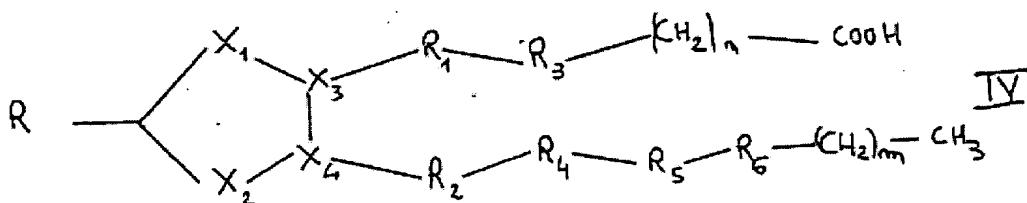
The Examiner asserts,

Casini, et al. disclose formula IV which includes pyrazolyl derivatives that generically encompasses many compounds of the instant formula I ... The disclosed formula IV has activity on smooth muscle and inhibit thrombocytes aggregation. Therefore, given the narrow scope of formula IV, it would have been within the level of the skilled scientist to select pyrazolyl compounds claimed herein for pharmaceutical use. Thus at the time the invention was made, it would have obvious to make and use pyrazolyl compounds of the instant formula I in view of the teaching above.

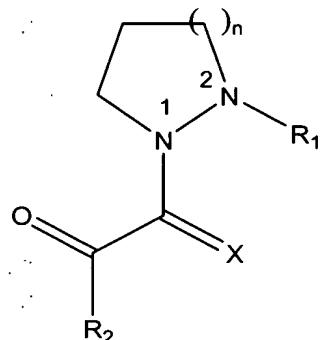
Office Action, pp. 5-6.

To establish a *prima facie* case of obviousness, there needs to be (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) the prior art references, when combined, must teach or suggest all the limitations of the claimed invention. *See* MPEP §2143 (Aug. 2001). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Applicants respectfully assert that the examiner has not met his burden.

Applicants believe a complete reading of Casini would not lead a person of skill in the art to the pyrazolyl compounds of the present invention. In fact, none of the specific compounds, described, purified, or for which data is provided are pyrazolyl compounds. Casini provides a general formula IV within which one may place a broad variety of compounds.



Formula IV from Casini



Formula I of present application

However, a complete reading of Casini makes clear that compounds of the pyrazolyl type (e.g., Formula I of claim 1 of the present application) were not intended to be understood as part of this disclosure. After providing the general formulas on page 3 for the compounds described in the application, Casini explains how one can obtain the compounds of the Casini invention:

The compounds according to the present invention can be obtained according to a general pattern (G), which also forms an object of the present invention, consisting in three successive steps at the end of which compounds of the general formula XI are formed, which can be traced to those of the general formula IV.

Casini, p. 4. The general pattern described above is provided on page 5 of Casini. This approach will only provide for a single nitrogen in the cyclic ring for positions X₃ and X₄.

A person of ordinary skill would appreciate the Casini approach does not extend to the pyrazolyl compounds and therefore, the compounds or the uses of such compounds, such as in the treatment of smooth muscle are not taught or suggested by the article. Since the Casini reference does teach or suggest all of the limitations of the current invention, or how to make and use the currently claimed compounds, Applicants believe Casini cannot serve as the basis of an obviousness rejection. Applicants respectfully request reconsideration and withdrawal of the rejection.

Atty. Dkt. No. (Old) 22754X
Atty. Dkt. No. 054707-0661
Appln. No. 09/835,523

CONCLUSION

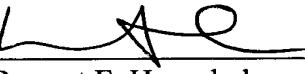
The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 8, 2006
FOLEY & LARDNER LLP
Customer Number:
22428
PATENT TRADEMARK OFFICE
Telephone: (202) 295-4163
Facsimile: (202) 672-5399

By 
Rouget F. Henschel
Attorney for Applicants
Registration No. 39,221